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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,346

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Jane Hirsh

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EXAMINER

HAGHIGHATIAN, MINA

ART UNIT

PAPER NUMBER

1616

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,346	<b>Applicant(s)</b> HIRSH ET AL.	
	<b>Examiner</b> MINA HAGHIGHATIAN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/05/07</u> .                                                | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of the Amendments and Remarks filed on 01/28/08. Claims 1 and 12 have been amended, and no claims cancelled or added. Accordingly, claims **1 and 3-13** are pending.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamarkin et al (US 20060140984) in view of Davis (5,143,717).**

Tamarkin et al disclose an alcohol-free cosmetic or pharmaceutical foam carrier comprising water, a hydrophobic solvent, a foam adjuvant agent, a surface-active agent and a water gelling agent (see abstract). The said alcohol-free foamable carriers, when placed in an aerosol container and combined with a liquefied gas propellant, create an oil in water emulsion, which upon release from the aerosol container, provides a therapeutically beneficial foam product (see [0025]). The foam carrier includes active agents, both water soluble and oil soluble (see [0063]). The foam is easily spreadable, allowing treatment of large areas as the arms, back, legs and breast (see [0064]). Examples of suitable propellants include volatile hydrocarbons such as butane and fluorocarbon gases (see [0115]). Examples of suitable active agents include antibiotics, antifungals, anesthetics, anti-inflammatory agents, corticosteroids, etc (see [0226]). Anti-inflammatory agents include clobetasone, betamethasone, diclofenac, ketorolac, ibuprofen (see [0245] and [0252]-[0257]). Antifungals include fluconazole, ketoconazole, clotrimazole, etc (see [0234] to [0237]). Antibiotics include penicillins, macrolides, beta-lactams, etc ([0229]). Anesthetics include lidocaine, bupivacaine, dibucaine, etc (see [0264]). Example 8 discloses a foam formulation comprising antibacterials in an amount of about 2%. Example 9 discloses a foam formulation comprising 1-2% antifungals. Example 10 discloses foam formulations comprising 0.05 to 1% of corticosteroid anti-inflammatory agents. Example 18 discloses a foam formulation comprising 4%

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lidocaine. Example 1 discloses a method of preparing the foam formulations. Tamarkin et al lacks disclosure on the oil phase being solid or semi-solid at room temperature.

Davis teaches burn foam and delivery system. The said foam is an antibiotic formulation useful in the treatment of burns and abrasions and adapted for topical application as a clinically water soluble foam (see abstract). The process steps in preparation of the said foam formulation include **heating and melting** the white petrolatum and other ingredients until all dints are melted and thoroughly to form the **oil phase** of the emulsion (see col. 4, lines 26-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tamarkin et al and Davis on forming foam compositions with a reasonable expectation of successfully preparing stable foam formulations for treating various disorders topically. Tamarkin et al teach an alcohol-free foam composition where the oil phase is liquid at room temperature and Davis teaches a foam formulation where the oil phase is solid at room temperature. One of ordinary skill in the art could have selected the solid phase of Davis over the liquid phase of Tamarkin et al with predictable results. In other words, **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamarkin et al (US 20060233721) in view of Quigley, Jr. et al (6,075,056).**

Tamarkin et al teach foamable composition for administration to the skin, body surface, body cavity or mucosal surface, e.g. the mucosa of the nose, mouth, eye, ear, respiratory system, etc. The foamable oil in water emulsion composition includes: an oil globule system, selected from the group consisting of oil bodies; and sub-micron oil globules, about 0.1% to about 5% by weight of an agent, selected from the group consisting of a surface-active agent, having an HLB value between 9 and 16 and a polymeric agent and a liquefied or compressed gas propellant at a concentration of about 3% to about 25% by weight of the total composition, water and optional ingredients are added to complete the total mass of 100% (see abstract and [0012]). The said foamable composition further includes at least one therapeutic agent such as an anti-inflammatory agent, antifungal or antibacterial, anesthetics etc (see [0026]). A polar solvent such as polyols ([0064]). The foamable compositions may be substantially alcohol-free, i.e. **free of short chain alcohols**, having up to 5 carbon atoms in their carbon chain skeleton (see [0066]). The formulations may be in an oil-in-water emulsion ([0080]). Suitable propellants include volatile hydrocarbons and fluorocarbon gases ([0098]). Claim 1 is drawn to a foamable oil in water emulsion composition comprising an oil globule, a non-ionic surface active agent, water and a liquefied propellant.

Tamarkin et al does not disclose an oil phase wherein the emulsion is a solid or semi-solid at room temperature.

Quigley, Jr. et al teach stable topical formulations comprising an antifungal agent and an anti-inflammatory steroid useful for treating fungal diseases and their related inflammation (see abstract). The topical formulations may be in the form of foam, cream, lotion, solution, etc (see col. 7, lines 31-34). To prepare the oil phase of the said topical formulations, it is said that the drugs are dissolved in the oil phase consisting of melted oil-soluble components of the formulation prior to addition of this phase to the aqueous phase (see col. 8, line 65 to col. 9, line 3). Other examples disclose similar process steps. Quigley also discloses that "white petrolatum is an emollient cream base and can be replaced by mineral oil" (see col. 8, lines 50-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tamarkin et al and Quigley, Jr. et al on stable topical formulations comprising active agents such as antifungal agents and anti-inflammatory steroids useful for treating various diseases with a reasonable expectation of successfully preparing stable and effective topical foam preparations. Tamarkin et al teach foam formulations wherein the oil phase is a liquid at room temperature and the formulations are substantially free of lower alcohols. Quigley teaches topical formulations that can be in the form of foam and wherein the oil phase of the oil-in-water emulsion is solid or semi-solid at room temperature and is mixed with

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the aqueous phase after being melted. One of ordinary skill in the art would have been able to select the solid oil phase of Quigley and the substantially free of alcohols foam formulation of Tamarkin et al with expected results. That is, **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Additionally, the claims would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.



Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1, 9-11** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5 and 17-19 of copending Application No. 11/128,947 (US 20050255048). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been obvious over the reference claims. Specifically, the foam composition comprising an antifungal or antibacterial active agents and propellant of the reference claims and the spray or foam formulations comprising one or more antifungal or antibacterial active agents of the instant claims are essentially the same or very similar in scope. One of ordinary skill in the art would have been able to make the simple modifications with a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims **1 and 9-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9-16 of copending Application No. 11/464,100 (US 20070036731). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been obvious over the reference claims. Specifically, the topical composition comprising a particulate material, wherein the particulate material comprises an antibiotic or an antifungal agent, and a propellant of the reference claims

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and the spray or foam formulations comprising one or more antifungal or antibacterial active agents of the instant claims are very similar in scope. One of ordinary skill in the art would have been able to make the simple modifications with a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims **1 and 3-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9-16 of copending Application No. 11/552,457 (US 20070154402). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been obvious over the reference claims. Specifically, the topical composition comprising one or more keratolytic agents in an oil-in-water emulsion and a propellant and one or more active agent such as an antibiotic, an antifungal agent, an anti-inflammatory agents, anesthetics, etc, of the reference claims and the aerosol foam formulations in an oil-in-water emulsion comprising one or more antifungal, antibacterial, anti-inflammatory or anesthetic agents of the instant claims are very similar in scope. One of ordinary skill in the art would have been able to make the simple modifications with a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant's arguments with respect to claims 1 and 3-13 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINA HAGHIGHATIAN whose telephone number is (571)272-0615. The examiner can normally be reached on core office hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mina Haghighatian/

Mina Haghighatian  
Primary Examiner  
Art Unit 1616